

REMARKS

Claims 1-22 are pending in the case.

In the Office Action, page 1, it is stated the scope of the examined subject being Group I from the restriction requirement:

Compounds of the formula (II) where :

G is all carbocyclic rings

Ar is all carbocyclic rings;

X is all carbocyclic rings;

Y is as claimed;

R1 as claimed except the heterocyclic or heteroaryl rings;

R2, R4, R5, R6, R11, R16, R18, R21 as claimed;

R3 is all acyclic moieties claimed;

R7-R10, R12-R15, R17, R19, R25, R26 are the carbocyclic rings claimed;

R20 is alkyl optionally partially or fully halogenated or phenyl;

R22, R24 cannot form a heterocyclic ring;

m as defined;

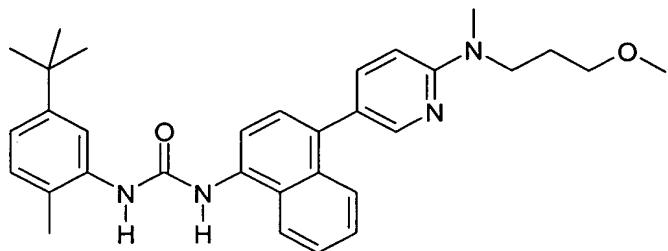
W is O or S;

Pharmaceutical compositions.

Applicants' attorney would like to point out however that, as mentioned in the response to the restriction requirement dated 5/27/2004, in a discussion with the Examiner on May 19, 2004, it was agreed upon to modify Group I as follows:

X is 5 or 6-membered rings containing 1 or 2 nitrogens; **R3** is all acyclic moieties listed. All other definitions, as identified in Group I of the present restriction requirement, is to remain the same.

Therefore, in view of this agreed modification, applicants had elected in response to the election/restriction requirement the compound:



Which is example 18, page 166 and is also found in claim 16, the 1st compound listed.

Applicants assume the scope of the claims identified by the Examiner in the present Office Action is an error because the Office Action states that example 18 was the elected species. Applicants await the Examiners written confirmation prior to canceling nonelected subject matter. Applicants respectfully request rejoinder of the method and process claims of equal scope upon a finding of allowable compound claims.

Claims 1-5 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-5, 8-17 of US patent no. 6,660,732. This rejection is traversed.

It is alleged that the 6,660,732 Z radical is a subgenus of the instant Z. Applicants respectfully disagree.

The instant application is a divisional case of US 6,660,732 application serial number 09/962,709. The Office Action of 09/962,709 attached herewith as *exhibit A* shows on page 2, point 3 that limitation to where Z is a ring was required. Therefore the patent's claim language, such as that in claim 1 reads:

phenyl, pyridinyl, pyrimidinyl, pyridazinyl, pyrazinyl, imidazolyl, pyrazolyl, triazolyl, tetrazolyl, furanyl, thieryl, pyranyl, each being optionally substituted with one to three halogen, C1-6 alkyl, C1-6 alkoxy, hydroxy, amino, mono- or di-(C1-3 alkyl)amino, C1-6 alkyl-S(O)m, CN, CONH2, COOH or phenylamino wherein the phenyl ring is optionally substituted with one to two halogen, C1-6 alkyl or C1-6 alkoxy;

tetrahydropyranyl, tetrahydrofuranyl, 1,3-dioxolanonyl, 1,3-dioxanonyl, 1,4-dioxanyl, morpholinyl, thiomorpholinyl, thiomorpholino sulfoxidyl, thiomorpholino sulfonyl, piperidinyl, piperidinonyl, piperazinyl, tetrahydropyrimidonyl, cyclohexanonyl, cyclohexanolyl, pentamethylene sulfidyl, pentamethylene sulfoxidyl,

pentamethylene sulfonyl, tetramethylene sulfide, tetramethylene sulfoxidyl or tetramethylene sulfonyl each being
optionally substituted with one to three nitrile, C1-6 alkyl, C1-6 alkoxy, hydroxy, amino, mono- or di-(C1-3
alkyl)amino-C1-3 alkyl, CONH2, phenylamino-C1-3 alkyl or C1-3 alkoxy-C1-3 alkyl;

A plain reading of the claims shows as emphasized in underline and italic that the listing of rings are definitions of Z, each Z ring can be substituted for the moieties in italics. The moieties in italics are not alternate possibilities for Z, but substitutions on the Z rings. The applications therefore is a proper divisional case of the US 6,660,732 patent, withdrawal of the obviousness-type double patenting is proper and respectfully requested.

Respectfully submitted,



Anthony P. Bottino
Attorney for Applicant(s)
Reg. No. 41,629

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT. 06877
Tel.: (203) 791-6764

I hereby certify that this correspondence is being
deposited with the U.S. Postal Service as first class
mail in an envelope addressed to:
Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
on September 24, 2004

By: Anthony P. Bottino
Reg. No. 41,629



Exhibit A

UNITED STATES PATENT AND TRADEMARK OFFICE

AB
d
d
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/962,709	09/25/2001	Rajashendar Betageri	9/158-161-I-D1	1480
28509	7590	06/02/2003		

BOEHRINGER INGELHEIM CORPORATION
900 RIDGEBURY ROAD
P O BOX 368
RIDGEFIELD, CT 06877

9-02-03

EXAMINER

RAYMOND, RICHARD L

ART UNIT

PAPER NUMBER

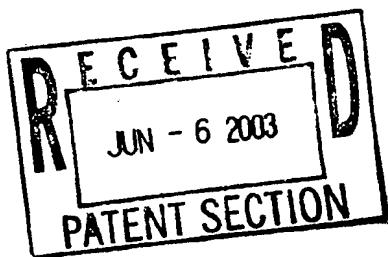
1624

12-02-03 LAST
DAY

DATE MAILED: 06/02/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.



ANTHONY BOTTINO
JUN 6 2003
RECEIVED

On Outbox